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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,372	06/19/2006	Yorikazu Takao	064766-0018	8204
53080 7590 09/08/2008 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, NW WASHINGTON, DC 20005-3096				
EXAMINER				
AGUSTIN, PETER VINCENT				
ART UNIT		PAPER NUMBER		
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MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/583,372

Applicant(s)

TAKAO ET AL.

Examiner

Peter Agustín

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) 4-10, 12-15 and 17-20 is/are withdrawn from consideration.
5) ☒ Claim(s) 1-3 and 11 is/are allowed.
6) ☒ Claim(s) 16 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 19 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. This application is a national stage entry (371) of PCT/JP04/18464, filed December 10, 2004.
2. Claims 1-20 are currently pending.

Election/Restrictions

3. Applicant's election without traverse of Species A (Figures 1-4) in the reply filed on July 14, 2008 is acknowledged.

Applicant identifies claims 1-3 & 11 as readable on the elected species. As noted by the examiner in the restriction requirement dated June 16, 2008, claim 16 is also readable on Species A; therefore, claims 1-3, 11 & 16 are being examined.

4. Claims 4-10, 12-15 & 17-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 14, 2008.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

6. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

7. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors, e.g.,

Page 11, line 14: "DESCRIPTION" should be --DESCRIPTION--.

Page 12, line 14: "EMBODING" should be --EMBODYING--.

Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

8. Claims 1-3, 11 & 16 are objected to because of the following informalities:

Claim 1, line 1: "recoding" should be --recording--.

Claim 1, line 1: "correcting" should be --correction--.

Claim 1, line 4: "a physical address position which is embedded" should be --physical address positions which are embedded--.

Claim 1, line 11: "detecting section" should be --detection section--.

Claim 1, line 24: "interpolation section" should be --interpolating section--.

Claim 2, line 5: "the wobble signals" should be --wobble signals--.

Claim 3, line 4: "physical positions" should be --physical address positions--.

Claim 11, lines 2-3: "a physical address position which is embedded" should be --physical address positions which are embedded--.

Claim 11, lines 5: "physical address position which is detected" should be --physical address positions which are detected--.

Claim 11, line 10: "detecting step" should be --detection step--.

Claim 11, line 23: "interpolation step" should be --interpolating step--.

Claim 16, lines 3-4: "a physical address position which is embedded" should be --physical address positions which are embedded--.

Claim 16, line 6: "physical address position which was detected" should be --physical address positions which were detected--.

Claim 16, line 11: "detecting step" should be --detection step--.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claim 16 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 16 is drawn to a "program" *per se*, therefore, fails to fall within a statutory category of invention.

A claim directed to a computer program itself is non-statutory because it is not:

A process occurring as a result of executing the program, or

A machine programmed to operate in accordance with the program, or

A manufacture structurally and functionally interconnected with the program in a manner which enable the program to act as a computer component and realize its functionality, or

A composition of matter.

See MPEP § 2106.01. Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of

causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

Allowable Subject Matter

11. Claims 1-3 & 11 are allowed over the prior art of record.
12. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record alone or in combination fails to teach or suggest:

in claim 1, "*a physical address position interpolating section for interpolating the physical address positions from the physical address position information which is stored in the physical address position storing section and the interval between the physical address positions which were measured by the physical address position interval measuring section; a sector top position detection section for detecting the top position of the respective sectors in the data which were recorded in the optical disc; a recording position deviation correction control section for detecting the recording position deviation amount from the physical address positions which were detected by the physical address position interpolation section using the physical address positions before performing additional recording processing which are stored in the physical*

address position storing section, and the sector top positions which were detected by the sector top position detection section, at carrying out an additional recording processing which records data continuously to the data region where the recording is already carried out on an optical disc, and generating a signal indicating to carry out recording position deviation correction based on the detected recording position deviation amount; and a recording position deviation correction section for performing correction of the recording position of the data by the contraction/extension of the recording sector on the basis of the signal outputted from the recording position deviation correction control section”.

Claim 11 has similar allowable limitations as claim 1.

Claims 2 & 3 are dependent upon claim 1.

Conclusion

13. The prior art made of record and not relied upon (see attached PTO-892 form) are considered pertinent to applicant's disclosure of deviations or offsets of physical address positions in optical recording media, and/or how these deviations or offsets are compensated during recording/reproduction of information.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Agustin whose telephone number is (571) 272-7567. The examiner can normally be reached on Monday-Thursday 8:30 AM-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter Vincent Agustin/
Patent Examiner, Art Unit 2627